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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,702	01/06/2000	JONATHAN VAN TASSEL	97-1804	2041

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EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
1774	20

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/478,702	VAN TASSEL ET AL.
Examiner	Art Unit	
Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 February 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,18 and 30-96 is/are pending in the application.

4a) Of the above claim(s) 52-58 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,18,30-51 and 59-96 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) All    b) Some \* c) None of:

        1. Certified copies of the priority documents have been received.

        2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .      6) Other: \_\_\_\_\_ .

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office Action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Allowable Subject Matter***

1. The indicated allowability of claims 1, 18, 30-31, and 59-69 is withdrawn in view of the newly discovered reference(s) to Jagannathan, 4,865,703. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 32-33, 35-36, 40-41, 70, 72, 74, and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Publication No. 475,592 (hereinafter the publication).

The publication teaches a tape that is removable from a carrier, said tape comprising a first component that is generally dielectric and conductive such as alumina and zirconia, wherein said tape additionally comprises a second component.

Accordingly, the publication anticipates the invention as claimed in claims 1, 32-33, 35-36, 40-41, 70, 72, 74, and 78.

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4. Claims 1, 18, 30, 32-35, 37-38, 40-44, 46-51, 59-61, 63, 68-70, 72-74, 77-83, 85-86, and 88-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Jagannathan 4,865,703.

Jagannathan teaches particulate magnetic recording media comprising a first material as required by claims 1, 30, and 34. Jagannathan teaches that his particulate magnetic recording media comprises at least two components (78) wherein at least one of said components is electrophoretically deposited, as required by claims 18, 40, 59, 69, 81-82, and 93. This component is particulate magnetic material and thus is generally dielectric and conductive as required by claims 35, 38, 44, 70, 74, 83, 86, and 88. See column 2, lines 15-16. The particulate media is deposited on a substrate that is on a carrier wherein the electrodes are energized, thereby resulting in a particulate media that is substantially continuous and removable from a carrier, as required by claims 33, 41, 42, 72, 85, 89-90, and 94-96. See column 7, line 66 through column 8, line 27. As to claims 37, 43, 60, 61, and 77, Jagannathan teaches forming a pattern by alignment of the particles. See column 6, lines 61-62. Furthermore, Jagannathan teaches that the first component can be formed at least partially on top of a second component, as required by claims 46, 79-80, and 91-92. As to claims 30 and 63, Jagannathan teaches an apparatus comprising a carrier and electrodeposition bath. As to claims 47 and 49, these properties are inherent in the particulate recording media of Jagannathan. Regarding claim 50, this claim does not set forth a clear positive recitation of the particulate tape being laminated. All that is required is that the particulate material be capable of functioning as claimed. Accordingly, the particulate

media of Jagannathan is capable of said functioning. Applicants should note that claims 1, 30, 40, 48, and 51 are product-by-process claims, wherein patentability is based solely on the product itself.

Therefore, the prior art teachings of Jagannathan anticipate the invention as claimed in the present claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 31, 45, 48, 62, and 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagannathan as applied above to claims 1, 18, 30, 32-35, 37-38, 40-44, 46-51, 59-63, 68-70, 72-74, 77-83, 85-86, and 88-96.

Jagannathan is as applied above but does not specifically teach using more than one electrophoretic deposition bath, various carriers, laminating the formed component to another surface or wiring interconnects. As to claim 31, Jagannathan teaches that a coating may be continually electrodeposited (column 9, lines 33-34). This teaching would have rendered obvious inclusion of more than one electrophoretic deposition bath in the process of Jagannathan. As to laminating as required by claim 62, it would have been obvious to the skilled artisan to laminate the particulate recording media of Jagannathan in order to provide increased strength to the substrate or to provide labeling. Regarding the specific carriers as set forth in claims 64-67, as well as

providing wiring interconnects as required by claim 45, these properties would have been obvious to choose and determine commensurate with the desired end product.

Accordingly, the prior art teachings of Jagannathan would have rendered obvious the invention as claimed in claims 31, 45, 62, and 64-67.

7. Claims 36, 39, 75-76, 71, 84, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagannathan as applied above to claims 1, 18, 30-35, 37-38, 40-51, 59-70, 72-74, 77-83, 85-86, and 88-96, in view of Grabbe 5,175,928 and "Electrophoretic Deposition – A Review" (hereinafter Gani).

Jagannathan is as set forth previously, but does not teach the specific particulate of the present claims. Grabbe teaches electrophoretic deposition of dielectric materials such as aluminum oxide and barium titanate and Gani teaches that various materials such as clays, alumina, silica, and metals can be electrophoretically deposited to form coatings. It would have been obvious to the skilled artisan at the time the invention was made, to use as the particulate material of Jagannathan any materials known in the art capable of electrophoretic deposition and acting as a dielectric or conductor, such as those particulates taught by Grabbe and Gani, motivated by the reasonable expectation of a known particle functioning in its known manner.

Therefore, when considered as a whole, the combined teachings of Jagannathan, Grabbe and Gani would have rendered obvious the invention as claimed in present claims 36, 39, 71, 75-76, 84, and 87.

Applicants have not clearly identified that which they regard as their invention. In particular, claims 1, 32, and 40 are product-by-process claims wherein patentability is

based solely on the product. Accordingly, no patentable weight is given to the process limitations. Hence, the requirement of electrophoretically depositing the particulate material has been given no patentable weight. Accordingly, claim 1 only requires "a first material"; claim 32 requires "a single component", however, the presence of the term "comprising" allows for the presence of other components; and claim 40 only requires "at least two components".

No claims are allowed.

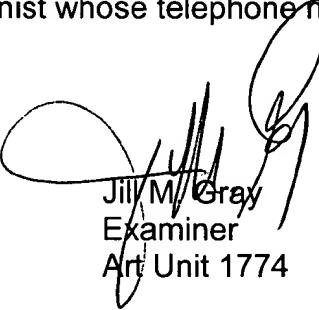
***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 703.308.2381. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9310 for regular communications and 703.872.9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.



Jill M. Gray  
Examiner  
Art Unit 1774

jmg  
July 31, 2003